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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSE R. BRUNHEROTO, PETER S. LEE, and
FRANK A. SCHAFFA

Appeal 2008-4727
Application 09/602,278
Technology Center 2600

Decided: October 29, 2008

Before JOSEPH F. RUGGIERO, MAHSHID D. SAADAT, and ROBERT E. NAPPI, *Administrative Patent Judges.*

NAPPI, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the rejection of claims 30 through 49.

We reverse the Examiner's rejections of these claims.

INVENTION

The invention is directed to a system for automated monitoring of quality of service of digital video material to be played. The system embeds a signature in each frame of the video information. The play-out device also generates a signature, compares the signatures, and computes play-out statistics for the digital video material. See pages 2 and 3 of Appellants' Specification. Claim 30 is representative of the invention and is reproduced below:

> 30. A system for monitoring quality of service of play out of a digital video program, the system comprising:
>
> a program source to,
>
> encode each frame of the digital video program with a first unique signature that identifies the frame as being associated with the digital video program;
>
> create a meta-stream for the digital video program, the meta-stream including a play-out schedule for the digital video program and a length of the digital video program; and
>
> prior to play-out of the digital video program, transmit the meta-stream to a play-out device; and
>
> the play-out device to compute statistics associated with play-out of the digital video program, the play-out device including,
>
> a signature engine to generate a second unique signature for each frame of the digital video program being played out; and
>
> a matching engine to compare the second unique signature generated for each frame with a corresponding first unique signature encoded with the frame, compare a time of the play-out of the digital video program with a time specified in the play-out schedule, and compare an actual duration of the play-out of the digital video program with the length of the digital video program specified in the meta-stream.

REFERENCES

Copriviza	US 5,319,453	Jun. 7, 1994
Echeita	US 5,826,165	Oct. 20, 1998
Iggulden	US 6,597,405 B1	Jul. 22, 2003

REJECTIONS AT ISSUE

Claims 30 through 32, 35 through 42, and 45 through 49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Copriviza in view of Echeita. The Examiner's rejection is on pages 3 through 8 of the Answer.

Claims 33, 34, 43, and 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Copriviza in view of Echeita and Iggulden. The Examiner's rejection is on page 8 of the Answer.

PRINCIPLES OF LAW

The purpose of the definiteness requirement of 35 U.S.C. § 112 is to ensure that the claims delineate the scope of the invention using language that adequately notifies the public of the patentee's right to exclude. *Datamize, LLC v. Plumtree Software, Inc,.* 417 F.3d 1342, 1347, (Fed. Cir. 2005) (citing *Honeywell Int'l, Inc. v. Int'l Trade Comm'n,* 341 F.3d 1332, 1338 (Fed. Cir. 2003). A claim is sufficiently definite under 35 U.S.C. § 112, second paragraph, if a person skilled in the field of the invention would reasonably understand it when it is read in the context of the specification. *Marley Mouldings Ltd. v. Mikron Industries, Inc.,* 417 F.3d 1356, 1359 (Fed. Cir. 2005).

ANALYSIS

Rejections of claims 30 through 39 under 35 U.S.C. § 103(a).

Appellants argue on pages 5 through 8 of the Brief that the system of independent claim 30 includes "a signature engine to generate a second unique signature for each frame of the digital program being played out" and that this feature is not taught or suggested by either Copriviza or Echeita. In response, the Examiner states, on page 9 of the Answer:

> When Copriviza is modified in view of Echieta [sic Echeita], those signatures which allow a system to align the advertisement reconciliation data with a corresponding advertisement, as taught by Echeita (col. 7, lines 37-43), are frame specific, as taught by Copriviza. It is the teaching found in Echeita regarding the desirability of frame counting (Echeita, col. 8, lines 34-40) for quality of service measurements that provides the nexus which links Echeita to Copriviza.

We disagree with the Examiner's analysis. The Examiner and Appellants appear to be in agreement that Copriviza teaches an apparatus for monitoring playback of video signals where each frame is encoded with a unique identifier at the source, and we also agree with this finding. However, we fail to see that either Copriviza or Echeita teaches or suggests generating a second unique signature for each frame at playback. Copriviza teaches that each frame is monitored at playback, and a determination is made as to whether any frames are missing. This determination is made by the amount of time that the source material was played and based upon the count of the frames. Copriviza, col. 5, ll. 11-28. Similarly, Echeita teaches an apparatus for monitoring playback of video signals (advertisements). Echeita's system includes with the video data "reconciliation data" which includes schedule data, duration of the advertisement, codes identifying the advertisement, and contract information. Echeita, col. 3, ll. 19-28. Echeita's

system also keeps track of the actual time and duration of the advertisement to be inserted into the reconciliation data. Col. 8, ll. 14-16. However, we do not find that Echeita teaches or suggests that a signature is generated at the play-out device for each frame. As claim 30 recites that the play-out device generates a second unique signature for each frame, we do not find that the combination of Copriviza and Echeita teaches all of the limitations of independent claim 30. Accordingly, we will not sustain the Examiner's rejection of independent claim 30 nor of dependent claims 31, 32 and 35 through 39 as being unpatentable over Copriviza in view of Echeita.

The Examiner's rejection of dependent claims 33 and 34 similarly relies upon Copriviza and Echeita to teach the limitations of independent claim 30. The Examiner relies upon the added teachings of Iggulden as evidence that the limitations of dependent claims 33 and 34 are obvious. The Examiner has not found, nor do we find that Iggulden provides teachings which remedy the above noted deficiency in the rejection of independent claim 30. Accordingly, we will not sustain the Examiner's rejection of claim 33 and 34 for the reasons discussed with respect to claim 30.

Rejections of claim 40 through 49 under 35 U.S.C. § 103(a)

Initially, we note that as discussed *infra*, we now reject claims 40 through 49 under 35 U.S.C. § 112 second paragraph as they are indefinite. Thus, the scope of the claims can not be determined. Our reviewing court has said that, it is wrong to rely upon speculative assumptions as to the meaning of claims and basing a rejection under prior art. *In re Steele* 305 F.2d 859, 862 (CCPA 1962). Thus, we will not sustain the Examiner's

rejections of these claims under 35 U.S.C. § 103(a) as we will not speculate as to the scope of the claims and as such can not determine whether the combination of the references teaches the claimed features.

NEW GROUNDS OF REJECTION UNDER 37 C.F.R. § 41.50(b)

Under 37 C.F.R. § 41.50(b), we enter a new ground of rejection under 35 U.S.C. § 112.

Independent claim 40 recites "A computer program product for monitoring quality of service … comprising instructions for: encoding … creating … prior to play-out of the digital video program, transmitting the meta-stream to a play-out device." Claim 40 further recites that "responsive to the play-out device playing out the digital video program, the play-out device computing statistics … including generating, … comparing ." Thus claim 40 clearly recites that there is one program product which performs the steps of encoding, creating, and transmitting the meta-stream. From Appellants' Specification it is apparent that these steps occur at one location, e.g. the program source item 10. However, it is unclear from claim 40 if either: a) the same program code also includes instructions directed to the play-out device which computes statistics (which according to Appellants' Specification are computed at a second location) (e.g. one disk which has program code to be used at both the transmitting location and the playout device location); or if b) the program code is merely performing the steps prior to the play-out device, and the claim omits some other mechanism which generates and compares the statistics associated with the play-out of the digital video program. Appellants' Specification does not provide a detailed discussion as to what form or where the computer program product

resides, which would guide the skilled artisan to ascertain the scope of this claim. Accordingly, we now reject claim 40 and the claims 41 through 49, which depend upon claim 40 under 35 U.S.C. § 112 as being indefinite.

ORDER

For the aforementioned reasons we will not sustain the Examiner's rejections of claims 30 through 49 under 35 U.S.C. § 103(a) and we enter a new rejection against claims 40 through 49 under 35 U.S.C. § 112.

The decision of the Examiner is reversed.

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
>
> (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

REVERSED

37 CFR § 41.50(b)

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